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*S.R.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/126,806 07/31/98 ANDREWS

R BD-03533

EXAMINER

QM12/1229

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BERRY, W

ART UNIT

PAPER NUMBER

3723

DATE MAILED:

12/29/00

*#11*

**Please find below and/or attached an Office communication concerning this application r proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/126,806

Applicant(s)

Andrews et al.

Examiner

Willie Berry, Jr.

Group Art Unit

3723



☒ Responsive to communication(s) filed on Oct 10, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3723

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over patent no. 4,860,721 to Matsuda in view of patent no. 5,916,013 to Naumann et al. Matsuda discloses a core (16), backing element (14), and diamond abrasive rim (12). Matsuda discloses the claimed invention except for the specific material and ranges of the core and braze. Naumann et al. teaches that it is known to use an active braze (column 16, lines 22-35) in a grinding machine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Matsuda to include the active braze as taught by Naumann et al. for the purpose of providing a means to bond the diamond grains to the core. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the specific material and ranges of the core and braze, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice and general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Art Unit: 3723

3. Claim 11 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick in view of Naumann et al. Fitzpatrick discloses a disc-shaped core and an abrasive rim with abrasive inserts. Fitzpatrick does not disclose the active braze. Naumann et al. teaches that it is known to use an active braze (column 16, lines 22-35) in a grinding machine. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Fitzpatrick to include the active braze as taught by Naumann et al. for the purpose of providing a means to bond the diamond grains to the core. The bolts used to mount the abrasive inserts to the core is considered to be an obvious matter design choice since bolts are a conventional means for mounting.

### ***Response to Arguments***

Applicant's arguments filed 10/10/00 have been fully considered but they are not persuasive. In response to applicant's argument that Matsuda in view of Naumann et al. do not disclose a dressing tool for refurbishing the grinding face of a grinding wheel, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136

Art Unit: 3723

USPQ 458, 459 (CCPA 1963). The examiner feels that the combination of Matsuda in view of Naumann and Fitzpatrick in view of Naumann discloses the claimed structural limitations.

*Conclusion*

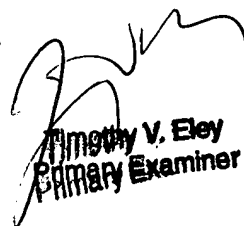
4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be directed to Willie Berry whose telephone number is (703) 308-7467.

WB

Willie Berry, Jr. :wbj  
December 28, 2000

  
Timothy V. Eley  
Primary Examiner

**ATTACHMENT TO AND MODIFICATION OF**  
**NOTICE OF ALLOWABILITY (PTO-37)**  
(November, 2000)

**NO EXTENSIONS OF TIME ARE PERMITTED TO FILE CORRECTED OR FORMAL DRAWINGS, OR A SUBSTITUTE OATH OR DECLARATION**, notwithstanding any indication to the contrary in the attached Notice of Allowability (PTO-37).

If the following language appears on the attached Notice of Allowability, the portion lined through below is of no force and effect and is to be ignored<sup>1</sup>:

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to comply will result in ABANDONMENT of this application. ~~Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).~~

Similar language appearing in any attachments to the Notice of Allowability, such as in an Examiner's Amendment/Comment or in a Notice of Draftperson's Patent Drawing Review, PTO-948, is also to be ignored.

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<sup>1</sup> The language which is crossed out is contrary to amended 37 CFR 1.85(c) and 1.136. See "Changes to Implement the Patent Business Goals", 65 Fed. Reg. 54603, 54629, 54641, 54670, 54674 (September 8, 2000), 1238 Off. Gaz. Pat. Office 77, 99, 110, 135, 139 (September 19, 2000).